UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,327	01/14/2000	Jeffrey Dwork	52352-314	6835

20277 7590 05/12/2003

MCDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER
PARTON, KEVIN S

ART UNIT	PAPER NUMBER
2153	7

DATE MAILED: 05/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/482,327	Applicant(s) DWORK ET AL.	
	Examiner Kevin Parton	Art Unit 2153	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and ~~an explanation of how the new or amended claims would be rejected is provided below or appended.~~

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1 and 4-21*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: The applicant states that the finality of the previous rejection was improper due to the assertion that claim 20 was not addressed in the original non-final rejection of all claims. However, please note that claim 20 was addressed in paragraph 27 of the original non-final rejection (paper #3). Further, please note that it was clearly noted on the Office Action Summary that claims 1-21 had all been rejected in that action. In reply to the applicant's original assertion that claim 20 was not addressed, it was pointed out in the final rejection (paper #5) that claim 20 was clearly addressed in the original Office Action and the only error was it's absence from the header paragraph, paragraph 19. It is clear that claim 20 was addressed in the original Office Action and in the final rejection Office Action, therefore the finality of the most recent Office Action is proper.

Applicants further arguments have been considered but are not persuasive. Please see the following reasons:

Applicant argues "However, neither Chong...in claim 1" (page 4, paragraph 6 - page 5, paragraph 4). The argument is not persuasive because, as cited in the previous office actions, the references do teach the suspension of transmission of data based on the availability of buffers. The duration is shown for stopping transmission for both a predetermined number of buffers in Chong (column 4, lines 26-30; column 7, lines 27-30) and combined with Ramakrishnan to show the stopping of transmission for a predetermined amount of time (column 8, lines 28-33). Note that both of these references deal with flow control and the use of buffers. The motivation for combination has been shown in the previous office action.

Applicant further argues "Moreover, the Examiner...second mode of operation" (page 5, paragraph 5 - page 6, paragraph 1). The argument is not persuasive for the reasons shown in the previous rejection. The references are from the same field of endeavor and it would benefit the overall system to combine the references. This renders the claims of the current application obvious.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant further argues "Independent claim 12...in claim 19" (page 6, paragraph 5 - page 8, paragraph 5. The argument is not persuasive for the same reasons stated in the previous office action with regards to the Fox reference. The Fox reference is used to show the utility of descriptors in buffer management. This was not to be an admission by the examiner but a clarification of why the secondary reference is appropriate. The combination of this with the Chong reference renders the present claims obvious to one of ordinary skill in the art with the motivation shown in the previous office action.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)

For all these reasons, the application is not in condition for allowance, and the previous final rejection of the claims is appropriate..

GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100